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EXAMINER

AWAD, AMR A

ART UNIT PAPER NUMBER

2675

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/067,667

**Applicant(s)**

TAYLOR, THOMAS H.

**Examiner**

Amr Awad

**Art Unit**

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 17-33 is/are allowed.
- 6) ☒ Claim(s) 12-16, 34-38 and 40-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                         |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 40-42 are objected to because of the following informalities: the claims shown to be dependent from claim 1, while in Applicant's argument, shown to be dependent from claim 34. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 34-38 and 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 34 recites, "the method comprising" in lines 4-5, and then recites, "a computer readable medium having computer readable instructions for performing the method, the method comprising". This makes the claim confusing because the Examiner is not sure whether the computer readable medium is step in the method or not. Examiner respectfully requests a clarification or correction

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-16 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Frank et al* (U.S. Patent 5,651,107) in view of Bertram et al. (US patent NO. 5,652,630; hereinafter referred to as Bertram).

Regarding **independent claim 12**, Frank teaches a system that is capable of displaying a video stream that is received from a video source, and displaying a user interface with a video stream in a single display window by teaching how to simultaneously display overlapping display objects on the display, each of the display objects having a degree of transparency determined by the transparency values associated with each of the display objects, such that the overlapping display objects are simultaneously visible on the display, and such that at least one of the display objects has two or more degrees of transparency (column 10, lines 55-62).

Furthermore, Frank teaches how to generate screen data by mixing a user interface and a video stream by utilizing a blending means (column 2, lines 38-55) wherein the user interfaces are represented by the multiple windows and the video stream are represented by the multiple images that are blended together (column 2, lines 38-55). Furthermore, Frank teaches how to display screen data in the display window wherein a view of the video in the display window is dependent on a level of transparency of the menu bar 30 (see figure 8,10). Also, Frank teaches a means of receiving an input from a user via a cursor control device 28 (see column 4, lines 57-67).

Furthermore, Frank teaches a technique for defining a transparency property indicating the degree of transparency of an image in a particular layer and a method of

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adjusting the level of transparency of a display device according to the input received from the user by teaching a method of selectively adjusting the one or more transparency values further includes displaying an image of a slider, said slider being adjustable by the user through the use of the cursor control device to selectively adjust said one or more transparency values (see column 11, lines 8-13).

Frank does not expressly teach that the system includes a set-top box (TV), and wherein the input comprising selection of one or more buttons on a remote control device of the set-top box.

However, Bertram (figure 1) teaches a video display which may be a television receiver (10) with associated set top device (30) and remote control (20) (abstract), and wherein the device is capable of overlaying both the video user interface (figures 14 and 16) (col. 40, lines 23-58).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Bertram, using the overlay displaying of the user interface and the video stream in a set-top box, to be used in Frank's device so as motivated by Bertram, to have a remote control with access to the resources of the system with which it is related, and wherein the navigation among functions available and resource allocation is accomplished by display of on-screen images which overlay or modify the images derived from the video/audio streams entering the television space, and which is accomplished by minimal buttons (col. 2, lines 19-25).

Regarding **independent claim 34, and for claim 35**, Frank teaches a system that is capable of displaying a video stream that is received from a video source, and a computer program (figure 2 at 50, 54, 56) that implements simultaneously displaying a user interface with a video stream in a single display window by teaching how to simultaneously display overlapping display objects on the display, each of the display objects having a degree of transparency determined by the transparency values associated with each of the display objects, such that the overlapping display objects are simultaneously visible on the display, and such that at least one of the display objects has two or more degrees of transparency (column 10, lines 55-62).

Furthermore, Frank teaches a computer readable medium having executable instructions for the above method (see figures 1, 2 at 10, 14, 16, 50, 56).

Furthermore, Frank teaches how to generate screen data by mixing a user interface and a video stream by utilizing a blending means (column 2, lines 38-55) wherein the user interfaces are represented by the multiple windows and the video stream are represented by the multiple images that are blended together (column 2, lines 38-55).

Furthermore, Frank teaches how to display screen data in the display window wherein a view of the video in the display window is dependent on a level of transparency of the menu bar 30 (see figure 8,10). Also, Frank teaches a means of receiving an input from a user via a cursor control device 28 (see column 4, lines 57-67). Furthermore, Frank teaches a technique for defining a transparency property indicating the degree of transparency of an image in a particular layer and a method of adjusting the level of transparency of a display device according to the input received

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from the user by teaching a method of selectively adjusting the one or more transparency values further includes displaying an image of a slider, said slider being adjustable by the user through the use of the cursor control device to selectively adjust said one or more transparency values (see column 11, lines 8-13).

Frank does not expressly teach that the system includes a set-top box (TV), and wherein the input comprising selection of one or more buttons on a remote control device of the set-top box.

However, Bertram (figure 1) teaches a video display which may be a television receiver (10) with associated set top device (30) and remote control (20) (abstract), and wherein the device is capable of overlaying both the video user interface (figures 14 and 16) (col. 40, lines 23-58).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Bertram, using the overlay displaying of the user interface and the video stream in a set-top box, to be used in Frank's device so as motivated by Bertram, to have a remote control with access to the resources of the system with which it is related, and wherein the navigation among functions available and resource allocation is accomplished by display of on-screen images which overlay or modify the images derived from the video/audio streams entering the television space, and which is accomplished by minimal buttons (col. 2, lines 19-25).

**Regarding claim 13**, Frank teaches how the user interface windows 255, 260 comprise one or more items that each have a level of transparency wherein a user

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would adjust a level of transparency for a selected item without adjusting levels of transparency for non-selected items (see column 9, lines 25-58, figure 8 at 255, 260).

Regarding **claims 14, 16, 36 and 38**, Frank teaches selectively adjusting, by user interface means, the one or more transparency values associated with at least one of the overlapping display objects, such that the transparency of the at least one display object is continuously variable from fully opaque to fully transparent (column 10, lines 63-67).

Regarding **claims 15 and 37**, Frank teaches how to generate screen data by mixing a user interface and a video stream by utilizing a blending (column 2, lines 38-55) wherein the user interfaces are represented by the multiple windows and the video stream are represented by the multiple images that are blended together (column 2, lines 38-55).

**With respect to claims 40-42**, as can be seen above, the combination of two references includes a set top device with a remote control (with mute button as required by claim 42) that can overlay a selection icons on video image (taught by Bertram), and display device that enables the user to control the transparency of the images.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to realize that changing the transparency by changing the volume would be easy using such combination because changing the volume requires the volume key to be displayed on the display in Bertram's device, and that would prompt a change in transparency in Frank's device. This is obvious because it merely a



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designer choice that can be done using the teaching of Frank, which make the device user friendly.

***Allowable Subject Matter***

6. Claims 1-11 and 17-33 are allowed.

***Response to Arguments***

7. Applicant's arguments filed 6/28/2005 with respect to claims 12-16 and 34-38 have been fully considered but they are not persuasive.

Applicant (page 17) argued that the reasoning by the Examiner for combining the two references falls well short of showing how each and every claim element is disclosed by the cited art or why there would be a motivation for combining the art to practice the claimed invention. Applicant argued that the Examiner fails to show or suggest how the level of transparency of a user interface or video content is adjusted according to input comprising selection of one or more remote control buttons. Examiner respectfully disagrees. Applicant cannot show non-obviousness by attacking references individually where as here the rejections are based on combination of references. **In re Keller, 208 USPQ 871 (CCPA 1981)**. As shown in the rejection above, Frank teaches mixing two user interface and video stream with different transparency. Bertram shows mixing two images (remote control and video images) in a TV screen, wherein the remote image includes buttons such as volume control buttons. Therefore by using the teaching of Bertram of using the device in a TV environment, a person of

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ordinary skill in the art at the time the invention was made would be motivated to create the modified device.

Applicant (bottom of page 17) argued that the motivation to combine does not make any sense. Examiner respectfully disagrees. The modified device created by combining the two reference would include two mixed images (taught by both references), wherein one of the images would include a remote control image (taught by Bertram), and the transparency can be controlled by the user (taught by Frank). Examiner simply states that if the remote control image is presented on the display (which also includes a volume control buttons), then the transparency of the image can be changed. This allows the user to view both video images as well as the image of the remote control, which make the device user friendly. Furthermore, the motivation quoted by the Applicant (page 17) is related to dependent claims 40-42, and not to the independent claim.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amr Awad whose telephone number is (571) 272-7764. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571)272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. A.

AMR A. AWAD  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'AMR A. AWAD', with a large, sweeping loop at the end.